

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: )  
 )  
Samantha Stetson, et al. )  
 ) Examiner: Raquel Alvarez  
Application No: 10/092,369 )  
 ) Art Unit: 3688  
Filed: March 6, 2002 )  
 ) Confirmation No: 8236  
For: METHOD AND APPARATUS FOR )  
SERVING A MESSAGE IN )  
CONJUNCTION WITH AN )  
ADVERTISEMENT FOR DISPLAY ON 0  
A WORLD WIDE WEB PAGE )  
\_\_\_\_\_ )

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPEAL BRIEF  
IN SUPPORT OF APPELLANTS' APPEAL  
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

This Brief is submitted in support of an appeal from a final decision by the Examiner, mailed on July, 11 2011 and a Notice of Appeal filed on October 11, 2011 in the above-referenced case.

If there are any further charges not accounted for herein, please charge them to our Deposit Account No. 19-3140.

Respectfully submitted,  
SNR Denton US LLP

Dated: December 12, 2011

/Tarek N. Fahmi/  
Tarek N. Fahmi  
Reg. No. 41,402

P.O. Box 061080  
Wacker Drive Station, Willis Tower  
Chicago, Illinois 60606-1080  
(650) 798-0320

Samantha Stetson, et al.  
Application No.: 09/092,369

Examiner: Raquel Alvarez  
Art Unit: 3688

## TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST.....	3
II. RELATED APPEALS AND INTERFERENCES .....	3
III. STATUS OF THE CLAIMS .....	3
IV. STATUS OF AMENDMENTS.....	4
V. SUMMARY OF THE CLAIMED SUBJECT MATTER .....	4
VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	10
VII. ARGUMENT .....	10
1. The Present Claims are Patentable over Thomas in view of Official Notice: .....	10
VIII. CONCLUSION .....	14
IX. APPENDIX A: CLAIMS .....	15
APPENDIX B: EVIDENCE .....	21
APPENDIX C: RELATED PROCEEDINGS.....	22

## **I. REAL PARTY IN INTEREST**

The real party in interest is Mindspark Interactive Network, Inc., a corporation of Delaware, having a principle place of business at 555 West 18th Street, New York, NY, 10011.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

## **III. STATUS OF THE CLAIMS**

### Current Pending Claims:

Claims 1, 8, 11-13, 16-19, 21, 22, 24, 26, 31, 33, 35, 37, 72, and 74 are presently pending and stand rejected by the Examiner under the Final Rejection mailed July, 11 2011.

In particular, Claims 1, 8, 11-13, 16-19, 21, 22, 24, 26, 31, 33, 35, 37, 72, and 74, are rejected under 35 USC 103(a) as being unpatentable over US Patent Number 6,128,663 to Thomas, hereinafter "Thomas" in view of Official Notice.

### Status of Non-Pending Claims:

Claims 2-3, 6-7, 9-10, 15, 20, 23, 27-30, 32, 34, 36, 43-44, 47, 52-53, 63, 66, 70-71, 73 and 76-77 were cancelled in a Preliminary Amendment filed on March 6, 2002.

Claims 38-42, 61-62, 64-65, 67-69 and 75 were cancelled in response to the Restriction Requirement issued on September 5, 2007.

Claims 78-82 were introduced as new claims in the response to Restriction Requirement issued on September 5, 2007.

Claims 4, 5, 57 and 59 were cancelled in the Amendment and Response to Office Action issued on December 31, 2007.

Claims 52 and 53 were cancelled in the Amendment and Response to Office Action issued on October 15, 2008.

Claims 14, 25, 45, 46, 49-56, 58, 60, 78, and 82 were cancelled in the Amendment and Response to Office Action issued on October 21, 2010.

#### IV. STATUS OF AMENDMENTS

There are no presently pending amendments.

#### V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Claims 1, 31, 72, and 74 are independent claims in this application and read as follows:<sup>1</sup>

1. A method comprising:

determining a banner advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page includes content other than the banner advertisement [**FIG. 1, 102; Specification page 8, lines 22-25**];

determining a message to be displayed on said World Wide Web page, [**FIG. 1, 104; Specification page 8, lines 26 – page 9, line 7**] wherein said message is thematically related to said banner advertisement [**Specification page 3, lines 5-8**];

determining targeting criteria associated with said message [**FIG. 1, 106; Specification page 9, lines 8-12**];

receiving a request to serve said World Wide Web page from a user [**FIG. 1, 108; Specification page 9, lines 13-15**];

receiving personal information about the user [**Specification page 3, lines 19-21 and page 19, lines 3-5**];

---

<sup>1</sup> Reference numbers as used in the drawings have been inserted in accordance with 37 C.F.R. §41.37(c)(1)(v). The use of such reference numbers should in no way be read as limiting the claim to the illustrated embodiment.

serving said World Wide Web page for display to the user [FIG. 1, 110; Specification page 9, lines 16-17];

serving said banner advertisement for display to said user on a portion of said World Wide Web page [FIG. 1, 112; Specification page 9, lines 17-18];

tailoring said message based, at least in part, on said targeting criteria and said personal information to include a portion of said personal information and direct the user's attention to the banner advertisement [FIG. 1, 114; Specification page 9, lines 17-20, page 3 and lines 19-21]; and

serving said tailored message for display to said user on said World Wide Web page separate from said banner advertisement, wherein the tailored message, at least a portion of the content other than the banner advertisement included in said World Wide Web page, and the banner advertisement are simultaneously displayed to the user [FIG. 1, 116, FIG. 4; Specification page 9, lines 20-25].

31. A method comprising:

determining a banner advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page includes content other than the banner advertisement [FIG. 1, 102; Specification page 8, lines 22-25];

determining a plurality of messages associated with said banner advertisement wherein each of said plurality of messages is thematically related to said banner advertisement [FIG. 3, 302; Specification page 20, lines 12-25];

determining targeting criteria associated with said plurality of messages **[FIG. 1, 106; Specification page 9, lines 8-12]**;

determining personal information **[FIG. 7, 304; Specification page 21, lines 4-9]**;

receiving a request to serve said World Wide Web page **[FIG. 1, 108; Specification page 9, lines 13-15]**;

serving said World Wide Web page for display to the user **[FIG. 1, 110; Specification page 9, lines 16-17]**;

serving said banner advertisement for display to said user on a portion of said World Wide Web page **[FIG. 1, 112; Specification page 9, lines 17-18]**;

selecting at least one of said plurality of messages based, at least in part, on said personal information and said targeting criteria **[FIG. 3, 306; Specification page 21, lines 18-26]**; and

tailoring the at least one selected message to include a portion of said personal information and direct the user's attention to the banner advertisement; and

serving said at least one of said plurality of messages for display to said user on said World Wide Web page separate from said banner advertisement, wherein the at least one of said plurality of messages, at least a portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user **[FIG. 3, 308, FIG. 4; Specification page 22, lines 1-8]**.

72. A system comprising:

- a memory [FIG. 12, 410, Specification page 27, lines 16-19];
- a communication port [FIG. 12, 402, Specification page 26, line 24 – page 27, line 1]; and
- a processor [FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19] connected to said memory and said communication port, said processor being operative to:
  - determine a banner advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page includes content other than the banner advertisement;
  - determine a message to be displayed on said World Wide Web page, wherein said message is thematically related to said banner advertisement;
  - determine targeting criteria;
  - receive a request to serve said World Wide Web page from a user;
  - serve said World Wide Web page for display to the user;
  - serve said banner advertisement for display to said user on a portion of said World Wide Web;
  - determine personal information about the user;
  - tailor said message based, at least in part, on said personal information and said targeting criteria to include a portion of said personal information and direct the user's attention to the banner advertisement;
  - and
  - serve said tailored message for display to said user on said World Wide Web page separate from said banner advertisement, wherein the tailored message, at

least a portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user.

74. An apparatus comprising:

means for establishing a banner advertisement to be displayed on a World Wide Web page wherein said World Wide Web page includes content other than the banner advertisement **[FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];**

means for establishing a message to be displayed on said World Wide Web page, wherein said message is thematically related to said banner advertisement **[FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];**

means for determining targeting criteria associated with said message **[FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];**

means for obtaining a request to serve said World Wide Web page from a-the user **[FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];**

means for transmitting said World Wide Web page for display to said user **[FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];**

means for transmitting said banner advertisement for display to said user on said World Wide Web page **[FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];**

means for retrieving personal information about the user **[FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];**



means for tailoring said message based, at least in part, on said personal information and said targeting criteria to include a portion of said personal information and direct the user's attention to the banner advertisement [FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19];

means for transmitting said tailored message for display to said user on said World Wide Web page separate from said banner advertisement on said World Wide Web page, wherein the tailored message, at least a portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user [FIG. 12, 400, Specification page 26, lines 24-27, page 28, 3-19].

To better appreciate the present invention, it is helpful to understand that, at the time the present application was filed in March of 2002, systems and methods for Web advertising suffered from ineffectiveness and reduced response rates. Specification, page 2, lines 25-28. The present invention overcomes the limitations of the past and provides methods and systems for providing enhanced Web advertisements with improved response rates.

As is apparent from these independent claims, the present invention concerns methods, systems, and apparatus that are configured to increase viewer response rates to advertising displayed on a Web page by providing a tailored message that includes personal information and directs the user's attention to a banner advertisement to be displayed on the Web page. Specification, page 3, lines 1-3.

In some embodiments, the message may be tailored to incorporate information that will improve the effectiveness of the advertisement. A message may be tailored based upon targeting criteria or information that is personal to a user. Specification, page 3, lines 19-21 and page 9, lines 17-20. The targeting criteria is associated with a message that is

thematically related to an advertisement so that a tailored message that is thematically related to the advertisement is served for display, separate from an advertisement. Specification, page 3, lines 5-8 and page 9, lines 8-12.

In another embodiment, a message to be served for display, separate from an advertisement, may be selected from a plurality of messages thematically related to an advertisement based on personal information and targeting criteria. Specification, page 20, lines 12-25 and page 21, lines 18-26.

In some cases, a message is served for display separate from an advertisement when one or more targeting criteria are met. Specification, page 23, lines 16-19. In one instance, when the target criteria are met, the message is displayed proximal to the advertisement. Specification, page 23, line 24 – page 24, line 1.

Systems and apparatus configured to perform the methods of the present application include a memory, a communication port, and a processor. See e.g. Specification, page 26, lines 24-27, page 27, lines 16-19, and page 28, lines 3-19.

## **VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to be reviewed on appeal are:

1. Whether claims 1, 8, 11-13, 16-19, 21, 22, 24, 26, 31, 33, 35, 37, 72, and 74 are patentable over *Thomas* in view of *Official Notice*.

## **VII. ARGUMENT**

### **1. THE PRESENT CLAIMS ARE PATENTABLE OVER THOMAS IN VIEW OF OFFICIAL NOTICE:**

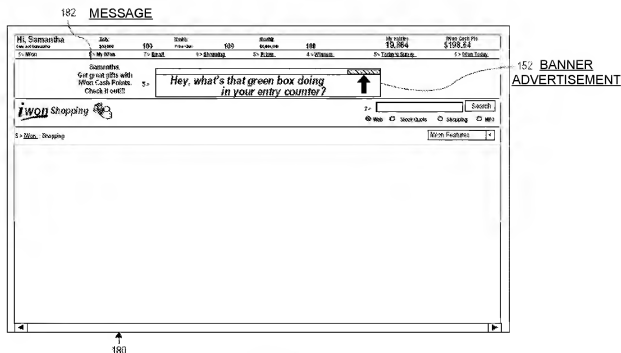
The pending claims are distinguishable over Thomas because they require a tailored message that includes personal information and directs the user's attention to a banner advertisement, neither of which are taught or suggested in Thomas or by the Official Notice cited in the Final Office Action.

When “determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP Section 2141.02 citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) and *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir.

1983), emphasis in the original. The Final Office Action only states that Thomas renders the feature “tailoring said message based on said targeting criteria and serving said tailored message for display on said World Wide Web page” obvious and is silent with regard to the features of tailoring a message to include personal information and direct the user’s attention to the banner advertisement recited in the present claims. Thus, it appears these features have not been considered when examining the invention as a whole under the standard stated above.

Furthermore, Figure 4 (annotated below) of the instant application illustrates an example of the above-mentioned features of the present claims. For example, claim 1 requires:

- tailoring said message (182) based, at least in part, on said targeting criteria and said personal information to include a portion of said personal information (the user’s name, “Samatha”) and direct the user’s attention to the banner advertisement (“get great gifts with iWon Cash Points. Check it out!!”); and
- serving said tailored message (182) for display to said user on said World Wide Web page (180) separate from said banner advertisement (152), wherein the tailored message (182), at least a portion of the content other than the banner advertisement included in said World Wide Web page, and the banner advertisement (152) are simultaneously displayed to the user.



**FIG. 4**

The Final Office Action states that Thomas teaches content provider sites that are able to provide customization or appropriate content to a user based on the user's demographic information and modifying a World Wide Web page by providing a greeting or selecting a variant of the World Wide Web page and that these teachings render the above noted features of the present claims obvious. However, Thomas fails to provide any details regarding the greeting or variant it discloses. At best, Thomas describes providing a World Wide Web page that includes a banner advertisement, a set of search results, and a message directing a user's attention to the search results as depicted in Figure 11 (annotated below).

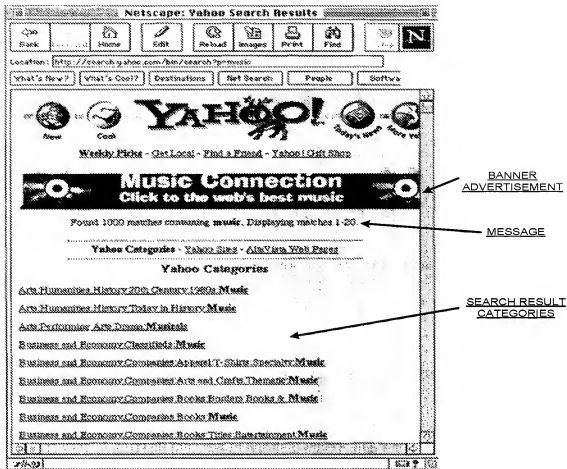


FIG. 11

Consequently, although Thomas discloses the display of a banner advertisement and a message, that message directs the user's attention away from the banner advertisement and toward search result categories, and therefore not only has the opposite effect of the message recited in the present claims but also fails to suggest the very feature of the claims for which it is being cited. In addition, the message of Thomas fails to include any personal information about a user.

Furthermore, Thomas simply does not teach or suggest any selection or customization of content or any provided greeting or variant of a World Wide Web page that includes personal information or directs a user's attention to a banner advertisement as presently claimed. The Official Notice cited in the Final Office Action does not address or overcome these deficiencies.

Hence, for at least these reasons the present claims are patentable over Thomas, even when considered in combination with the Official Notice cited in the Final Office Action. All of the other currently pending claims include features similar to those claim 1 and are patentable over Thomas, even when considered in combination with the Official Notice cited in the Final Office Action for at least the same reasons as claim 1. Applicants, accordingly, respectfully request withdrawal of the rejections of claims 1, 8, 11-13, 16-19, 21, 22, 24, 26, 31, 33, 35, 37, 72, and 74 under 35 U.S.C. § 103 as being unpatentable over Thomas in view of Official Notice.

#### **VIII. CONCLUSION**

For the foregoing reasons, Appellants respectfully request reversal of the present rejections and allowance of the present claims.

## **IX. APPENDIX A: CLAIMS**

The claims on appeal read as follows:

1. A method comprising:
  - determining a banner advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page includes content other than the banner advertisement;
  - determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said banner advertisement;
  - determining targeting criteria associated with said message;
  - receiving a request to serve said World Wide Web page from a user;
  - receiving personal information about the user;
  - serving said World Wide Web page for display to the user;
  - serving said banner advertisement for display to said user on a portion of said World Wide Web page;
  - tailoring said message based, at least in part, on said targeting criteria and said personal information to include a portion of said personal information and direct the user's attention to the banner advertisement; and
  - serving said tailored message for display to said user on said World Wide Web page separate from said banner advertisement, wherein the tailored message, at least a portion of the content other than the banner advertisement included in said World Wide Web page, and the banner advertisement are simultaneously displayed to the user.
- 2 - 7. (Cancelled)
8. The method of claim 1, further comprising:
  - determining personal information prior to said serving of said tailored message.
- 9 - 10. (Cancelled)

11. The method of claim 1, further comprising:  
setting a first time period.
12. The method of claim 11, wherein said serving of said tailored message occurs in at least said first time period after said serving of said World Wide Web page.
13. The method of claim 11, wherein said serving of said tailored message occurs in at least said first time period after said serving of said banner advertisement.
- 14 - 15. (Cancelled)
16. The method of claim 1, wherein said serving of said tailored message includes causing said tailored message to be displayed on said World Wide Web page for a fixed period of time.
17. The method of claim 1, further comprising:  
causing said tailored message to no longer be displayed on said World Wide Web page; and  
serving a second message such that the second message, the portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user.
18. The method of claim 1, further comprising:  
determining if said targeting criteria has been met prior to said serving of said tailored message.
19. The method of claim 1, further comprising:  
determining if said targeting criteria has been met prior to said serving of said banner advertisement.
20. (Cancelled)



21. The method of claim 1, further comprising:  
determining external information.
22. The method of claim 21, wherein said tailoring of said message is based, at least in part, on said external information.
23. (Cancelled)
24. The method of claim 1, wherein said World Wide Web page is arranged such that said banner advertisement is displayed proximal to said tailored message.
25. (Cancelled)
26. The method of claim 1, further comprising:  
changing a display attribute of at least a portion of said tailored message.
- 27 - 30. (Cancelled)
31. A method comprising:  
determining a banner advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page includes content other than the banner advertisement;  
determining a plurality of messages associated with said banner advertisement wherein each of said plurality of messages is thematically related to said banner advertisement;  
determining targeting criteria associated with said plurality of messages;  
determining personal information;  
receiving a request to serve said World Wide Web page;  
serving said World Wide Web page for display to the user;  
serving said banner advertisement for display to said user on a portion of said World Wide Web page;

selecting at least one of said plurality of messages based, at least in part, on said personal information and said targeting criteria; and

tailoring the at least one selected message to include a portion of said personal information and direct the user's attention to the banner advertisement; and

serving said at least one of said plurality of messages for display to said user on said World Wide Web page separate from said banner advertisement, wherein the at least one of said plurality of messages, at least a portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user.

32. (Cancelled)

33. The method of claim 31, further comprising:

tailoring said at least one of said plurality of messages based, at least in part, on said personal information prior to serving said at least one of said plurality of messages.

34. (Cancelled)

35. The method of claim 31, further comprising:

tailoring said at least one of said plurality of messages prior to serving said at least one of said plurality of messages.

36. (Cancelled)

37. The method of claim 31, wherein said World Wide Web page is designed such that said banner advertisement is displayed proximal to said at least one of said plurality of messages.

38 - 71. (Cancelled)

72. A system comprising:

a memory;  
a communication port; and  
a processor connected to said memory and said communication port, said processor being operative to:

determine a banner advertisement to be displayed on a World Wide Web page, wherein said World Wide Web page includes content other than the banner advertisement;

determine a message to be displayed on said World Wide Web page, wherein said message is thematically related to said banner advertisement;

determine targeting criteria;

receive a request to serve said World Wide Web page from a-the user;

serve said World Wide Web page for display to the user;

serve said banner advertisement for display to said user on a portion of said World Wide Web;

determine personal information about the user;

tailor said message based, at least in part, on said personal information and said targeting criteria to include a portion of said personal information and direct the user's attention to the banner advertisement; and

serve said tailored message for display to said user on said World Wide Web page separate from said banner advertisement, wherein the tailored message, at least a portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user.

73. (Cancelled)

74. An apparatus comprising:

means for establishing a banner advertisement to be displayed on a World Wide Web page wherein said World Wide Web page includes content other than the banner advertisement;

means for establishing a message to be displayed on said World Wide Web page, wherein said message is thematically related to said banner advertisement;

means for determining targeting criteria associated with said message;

means for obtaining a request to serve said World Wide Web page from a the user;

means for transmitting said World Wide Web page for display to said user;

means for transmitting said banner advertisement for display to said user on said World Wide Web page;

means for retrieving personal information about the user;

means for tailoring said message based, at least in part, on said personal information and said targeting criteria to include a portion of said personal information and direct the user's attention to the banner advertisement;

means for transmitting said tailored message for display to said user on said World Wide Web page separate from said banner advertisement on said World Wide Web page, wherein the tailored message, at least a portion of the content other than the banner advertisement included in said World Wide Web page and the banner advertisement are simultaneously displayed to the user.

75 - 82. (Cancelled)

## **APPENDIX B: EVIDENCE**

None.

## **APPENDIX C: RELATED PROCEEDINGS**

None.